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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,557	01/02/2002	Christian Kraft	367.40493X00	7117

20457 7590 04/06/2005

ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 NORTH SEVENTEENTH STREET  
SUITE 1800  
ARLINGTON, VA 22209-3873

EXAMINER

KE, PENG

ART UNIT PAPER NUMBER

2174

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/936,557

Applicant(s)

KRAFT, CHRISTIAN

Examiner

Peng Ke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is responsive to communications: Amendment, filed on 11/24/04.

This action is final.

Claims 15-39 are pending in this application. Claims 15, 16, 25, 29, 30 and 39 are independent claims. In the Amendment, filed on 11/24/04, Claims 1-14 were cancelled, and claims 15-39 were added.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 29, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Deluca et al., International Publication No. WO 97/19429.

As per claim 15, Deluca teaches a method for handling messages transmitted between communication terminals via a wireless network comprising:

generating a compound message including a text part and at least one graphical icon part, (see page 5, lines 13-14; Examiner interprets the image generated by the text #07 to be an icon)

the compound message generation including reading a user inputted text part (see page 5, lines 13-21; Examiner interprets “#07Tom?” to be a compound message) and

converting the inputted text part into a predefined message text format, (see page 10, lines 15-22; Examiner interprets the house address and the telephone number to be predefined text messages because they are automatically generated based on upon user selection) ~~on~~ ~~on~~

adding graphical part to the message, the graphical part including a record for each of the at least one graphical icon part in a graphical format, (see page 10, lines 15-22; Examiner interprets the graphical image of a office to be an icon because a set of predetermined program instructions is executed upon the user's selection of the image)

and adding position information in the message defining a position of the at least one graphical icon part in the text part (see figure page 7, lines 4-32; page 9, lines 6-20; The position information of the graphical icons is included in the message because the arrangement of the images is based on the input order of the graphical icons' code. Furthermore, when compounded message is between a group of text and a graphical icon, the text is always displayed beneath the picture. Therefore the single # symbol defines the position of the graphical icon so that it will always be on the top of the text) and

transmitting of the message via the wireless network (see page 3, lines 2-15; Examiner interprets radio communication network to be a wireless network).

As per claims 29 and 39, they are rejected with the same rationale as claim 1. (see rejection above)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 19-25, 30, and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugio et al. US 6,032,025 in view of Mochizuki US 5,828,313.

As per claim 16, Sugio teaches a communication terminal for handling messages and comprising:

- a controller,
- a transceiver for communicating with a wireless communication network, and
- a user interface through which the user operates the terminal, the user interface including a display (see Sugio, column 2, lines 30-50),

- message editor application allowing the user to generate a compound message including a text part and at least one graphical icon part; (see Sugio, column 2, lines 30-42 and column 7, lines 29-60) and

- wherein the controller generates the compound message for being transmitted via the transceiver (see Sugio, column 2, lines 34-36) including

- a text part in a predefined message text character format (see Sugio, column 7, lines 41-42),

- a graphical part including a record for each of the at least one graphical icon part in a graphical format (see Sugio figure 5, col. 6, lines 60-col7, lines 10).

However, Sugio fail to teach information in the message defining a position of the at least one graphical icon part in the text part.

Mochizuki teaches information in the message defining a position of the at least one graphical Icon part in the text part. (see Mochizuki, column 2, lines 40-47)

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It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the method of Mochizuki with the method of Sugio in order to allow more user control over used screen space.

As per claim 19, Sugio and Mochizuki teach a communication terminal according to claim 16. Sugio further teaches wherein the message editor application allows the user to copy a pre-stored graphical Icon from a memory associated with the controller and containing a plurality of clip art graphical icons. (see Sugio, column 6, lines 27-42 and column 7, lines 48-52)

As per claim 20, Sugio and Mochizuki teach a communication terminal according to claim 16. Sugio further teaches the communication terminal comprising a message reader application for automatically converting a received compound message into a displayable format based on the text part and the at least one graphical icon part. (see Sugio, column 9, lines 7-22).

As per claim 21, Sugio and Mochizuki teach a communication terminal according to claim 19. Sugio further teaches the method wherein the message reader application includes means for allowing the user to store the at least one graphical part in the memory associated with the controller and containing a plurality of graphical icons. (see Sugio, column 6, lines 27-34)

As per claim 22, Sugio and Mochizuki teach a communication terminal according to claim 16. Sugio further teaches wherein the message editor application allows the user to manually generate a graphical icon on the display by selectively marking dots in an icon matrix. (see Sugio, column 17, lines 36-43)

As per claim 23, Sugio and Mochizuki teach a communication terminal according to claim 22. Sugio teaches wherein the message editor application allows the user to store a

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manually entered graphical icon In the memory associated with the controller and containing a plurality of graphical icons. (see Sugio, column 18, lines 29-35)

As per claim 24, Sugio and Mochizuki teach a communication terminal claim 16. Sugio further teaches wherein the message editor application allows the user to input a plurality of graphical parts In the graphical part of the message and information in the message to display the plurality of graphical parts as an animation sequence. (see Sugio, column 42, lines 19-22)

As per claim 25, it is rejected with the same rationale as claim 16. Supra

As per claim 30, it is rejected with the same rationale as claim 16. Supra

As per claim 33, which is dependant on claim 30, it is of the same scope as claim 19.

Supra.

As per claim 34, which is dependant on claim 30, it is of the same scope as claim 20.

Supra.

As per claim 35, which is dependent on claim 30, it is of the same scope as claim 21.

Supra.

As per claim 36, which is dependent on claim 30, it is of the same scope as claim 22.

Supra.

As per claim 37, which is dependent on claim 30, it is of the same scope as claim 23.

Supra.

As per claim 38, which is dependent on claim 30, it is of the same scope as claim 24.

Supra

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Claims 17, 18, 27, 28, 31, and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Sugio et al. US 6,032,025 in view of Mochizuki US 5,828,313 further in view of Medina US 6,047,828.

As per claim 17, Sugio and Mochizuki teach a communication terminal according to claim 16. However, Sugio and Mochizuki do not teach wherein the message generated by the controller includes a header part including the position information. Medina teaches wherein a message includes a header part including position information of graphics. (see Medina, column 3, lines 34-66) It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Sugio and Mochizuki with the method <sup>GF</sup>Medina in order to allow image data and text data to be properly reconstructed into their proper special relationships <sup>KK</sup>

As per claim 18, Sugio, Mochizuki and Medina teach a communication terminal according to claim 17. Medina teaches wherein the header part of the message furthermore includes information about graphics size. (see Medina, column 3, lines 34-66)

As per claim 26, Sugio, Mochizuki and Medina teach a communication terminal according to claim 17. Sugio teaches wherein the message editor application allows the user to copy a pre-stored graphical icon from a memory associated with the controller and containing a plurality of clip art graphical icons. (see Sugio, column 6, lines 27-42 and column 7, lines 48-52)

As per claim 27, Sugio, Mochizuki and Medina teach a communication terminal according to claim 18. Sugio teaches wherein the message editor application allows the user to copy a pre-stored graphical icon from a memory associated with the controller and containing a plurality of clip art graphical icons. (see Sugio, column 6, lines 27-42 and column 7, lines 48-52)



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As per claim 28, which is dependent on claim 17, it is of the same scope as claim 18.

Supra

As per claim 31, which is dependent on claim 30, it is of the same scope as claim 17.

Supra

As per claim 32, which is dependent on claim 31, it is of the same scope as claim 18.

Supra

### ***Response to Argument***

Applicant's arguments filed on 11/24/04 have been fully considered but they are not persuasive.

Applicants' argument focused on the following:

1) Applicant argues that Deluca et al. fails to teach position information.

1) Examiner disagrees. During patent examination, the pending claims must be "given \*>their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)

In this case, the claims recites "adding position information in the message defining a position of the at least one graphical icon part in the text part", and Deluca teaches this limitation because arrangement of the images is based on the input order of the graphical icons' code.

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(figure page 7, lines 4-32; page 9, lines 6-20) Furthermore, when compounded message is between a group of text and a graphical icon, the text is always displayed beneath the picture.

(paragraph, lines 12-27) Therefore the single # defines the position of the graphical icon so that it will always be on the top of the text. (paragraph, lines 12-27)

2) Applicant argues that Sugio et al fails to teach graphical format.

2) Examiner disagrees. Sugio teaches arranging text and graphical parts of a compounded message in the predefined positions. (See Sugio, figure 5, col. 6, lines 60-col7, lines 10) Examiner interprets this predefined arrangement to be graphical format. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)

3) Applicant argues that there is no reason to combine Sugio with Mochizuki.

3) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Mochizuki's method is design<sup>ed</sup> to alleviate the problem that occurs in pre-<sup>KL</sup>positioned messages. (See Mochizuki, col. 1, lines 25-40) Specifically, because when the messages format is pre-define<sup>d</sup>, the essential information of the message tends to disappear from<sup>KL</sup> the initial display page of the message. (See Mochizuki, col. 1, lines 25-40) Furthermore, Sugio teaches displaying the compounded message in a pre-defined format. (See Sugio, figure 5, col. 6,

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lines60-col7, lines 10) Therefore it would be obvious to use Mochizuki's teaching to solve the problem that occurs in Sugio's pre-format compounded messages.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peng Ke whose telephone number is (571) 272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peng Ke

  
KRISTINE KINCAID  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100